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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212024
Party	Defendant Brooks Entertainment Inc.
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Date	11/11/2014
Attachments	TTAB_Response To Rule 56(D) Discovery (91212024).pdf(97896 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No.: 91212024

In the Matter of Application
Serial No. 85/551,808

For the mark: "S.O.B."

Filed on: February 24, 2012

Published in the Official Gazette on:
July 23, 2013

Opposition No. 91212024

REPUBLIC TECHNOLOGIES (NA), LLC

Opposer,

v.

BROOKS ENTERTAINMENT, INC.

Applicant.

APPLICANT'S RESPONSE TO
OPPOSER'S REQUEST FOR RULE 56(D) DISCOVERY

Brooks Entertainment, Inc. (Applicant") hereby responds to Opposer's Request For Rule 56(D) Discovery ("Opposer's Request").

In Applicant's Motion For Summary Judgment, Applicant clearly sets forth that Applicant's mark and Opposer's marks are sufficiently dissimilar. As Opposer acknowledges in Opposer's Request, it propounded extensive discovery requests on Applicant during the discovery phase of this proceeding, to which Applicant provided responses thereto. Therefore, any facts that Opposer believes will support its position are

already in its possession. Applicant respectfully requests that the Board deny Opposer's Request.

Without discounting Applicant's request to deny Opposer's Request, in the event that the Board is not convinced by Applicant's response set forth herein, it, alternatively, requests that the Board consider bifurcating this proceeding, and ordering that the primary claim, likelihood of confusion, be decided by the Board's Accelerated Case Resolution ("ACR") program.

Federal Rule of Civil Procedure 56(d) states in pertinent part:

"If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, **the court may…issue any other appropriate order.**" [**Emphasis Added**]. Fed. R. Civ. Proc. 56(d)(3). In trademark opposition proceedings, the Board ordering parties to ACR is appropriate. *Franpovi, S.A. v. Rosalinda Wessin and Daniel Pena*, 89 USPQ2d 1637, 1638 and 1640 (TTAB 2009). ACR is an efficient method to resolve frequent claims, such as likelihood of confusion. It will allow the Board to dispose of the primary claim in this proceeding, without subjecting the parties to the cumbersome effects of essentially re-open discovery.

Opposer's likelihood of confusion claim is based on facts that are different from the facts that allegedly support its other claims, so it would not prejudice Opposer. The other claims could be deferred and decided after an ACR that decides the likelihood of confusion claim. Both parties have already filed Motions for Summary Judgment with the Board so the respective positions are already clear.

Applicant believes that the efficiency of ACR is a well-suited method for determining whether a likelihood of confusion exists between Applicant's mark and Opposer's marks, so it respectfully requests the Board to order the parties to ACR, as an alternative to granting Opposer's Request.

Dated: November 11, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S REQUEST FOR RULE 56(D) DISCOVERY was served via U.S. Mail, postage prepaid, on this 11th day of November 2014, upon the attorney of record for Opposer:

Antony J. McShane
Neal, Gerber & Eisenberg, LLP
2 North LaSalle Street, Suite 1700
Chicago, Illinois 60602

By: /Richard B. Jefferson/
Richard B. Jefferson

Date: November 11, 2014

CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing APPLICANT'S RESPONSE TO OPPOSER'S REQUEST FOR RULE 56(D) DISCOVERY has been filed electronically with the Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on November 11th, 2014.

By: /Richard B. Jefferson/
Richard B. Jefferson

Date: November 11, 2014